

IN THE U.S. PATENT AND TRADEMARK OFFICE

Appellants: James A JOHANSON et al.
Application No.: 09/777,884
Art Unit: 2452
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Examiner: Dohm Chankong
For: BLUETOOTH DEVICE POSITION DISPLAY
Attorney Docket No.: 129250-001020/US

APPELLANTS' BRIEF ON APPEAL

MAIL STOP APPEAL BRIEF - PATENTS

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November 1, 2010

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APPELLANTS' BRIEF ON APPEAL

I. REAL PARTY IN INTEREST:

The real party in interest in this appeal is Alcatel-Lucent. Assignment of the application was submitted to the U.S. Patent and Trademark Office and recorded at Reel 011565, Frame 0492.

II. RELATED APPEALS AND INTERFERENCES:

The Board of Patent Appeals & Interferences has previously issued a decision in this application on August 24, 2009 as Appeal No. 2009-000929.

III. STATUS OF CLAIMS:

Claims 3, 5, 19, 30-35 and 37 are pending in the application, with claims 19 and 32 being written in independent form. Claims 1, 2, 4, 6-18, 20-29 and 36 have been cancelled.

Claims 19 and 32 were rejected under 35 U.S.C. §112, first paragraph. Claims 3, 5, 19 and 30-37 were rejected under 35 U.S.C. §103(a) based on the combination of U.S. Patent No. 6,204,844 to Fumarolo et al ("Fumarolo"), U.S. Patent No. 6,246,376 to Bork et al ("Bork") and U. S. Patent No. 5,907,293 to Tognazzini ("Tognazzini").

Claims 3, 5, 19, 30-35 and 37 are being appealed.

IV. STATUS OF AMENDMENTS:

An Amendment After Final ("AAF") was filed on August 5, 2010. In an Advisory Action dated August 11, 2010, the Examiner stated that the amendments in the AAF would be entered, but the amendments did not place the application in condition for allowance.

V. SUMMARY OF CLAIMED SUBJECT MATTER:

(i). Overview of the Subject Matter of the Independent Claims

The present invention is directed at methods and devices for selecting a nearby device to communicate with, where the device is selected from devices that have not been previously grouped. More specifically, independent claim 19 reads as follows (specification citations are in parenthesis):

19. A method for selecting a nearby device, from among a plurality of nearby devices that are not grouped, to communicate with, comprising the steps of:

transmitting a Bluetooth signal (page 6, lines 1-4 and page 8, line 16 to page 9, line 9);

detecting a plurality of Bluetooth signals from the nearby devices that are not grouped (page 6, line 11 to page 7, line 3), **each signal containing GPS coordinates of at least one nearby device and a device type of the at least one nearby device** (page 6, lines 1-19 and page 8, line 16 to page 9, line 9); **and**

selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates (page 6, line 19 to page 7, line 12).

Independent claim 32 reads as follows:

32. A device for selecting a nearby device, from among a plurality of nearby devices that are not grouped, to communicate with, the device operable to:

transmit a Bluetooth signal (page 6, lines 1-4 and page 8, line 16 to page 9, line 9);

detect a plurality of Bluetooth signals from the nearby devices that are not grouped (page 6, line 11 to page 7, line 3), **each signal containing GPS coordinates of at least one nearby device and a device type of the at least one nearby device** (page 6, lines 1-19 and page 8, line 16 to page 9, line 9); **and**

selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates (page 6, line 19 to page 7, line 12).

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In order to make the overview set forth above concise the disclosure that has been included, or referred to, above only represents a portion of the total disclosure set forth in the specification that supports the independent claims.

(ii). The Remainder of the Specification Also Supports the Claims

The Appellants note that there may be additional disclosure in the specification that also supports the independent and dependent claims. Further, by including the specification citations in parenthesis above the Appellants do not represent that this is the only evidence that supports the independent claims nor do Appellants necessarily represent that these citations alone can be used to fully interpret the claims of the present invention. Instead, the citations provide background support as an overview of the claimed subject matter.

VI. GROUNDS OF REJECTION TO BE REVIEWED ON APPEAL:

Appellants seek the Board's review and reversal of the rejection of: (a) claims 19 and 32 based on 35 U.S.C. §112, first paragraph; and (b) claims 3, 5, 19 and 30-37 under 35 U.S.C. §103(a) based on the combination of Fumarolo, Bork and Tognazzini.

VII. ARGUMENTS:

A. The Section 112 Rejections

Claims 19 and 32 were rejected under 35 U.S.C. §112, first paragraph, the Examiner taking the position that the phrase "that are not grouped" is a negative limitation that does not have basis in the original disclosure. The Appellants disagree for at least the following reasons.

The Appellants note that "[t]he current view of the courts is that there is nothing inherently ambiguous or uncertain about a negative limitation. So long as the boundaries of the patent protection sought are set forth definitely, albeit

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negatively, the claim complies with the requirements of 35 U.S.C. 112, second paragraph", *see MPEP 2173.05(i)*.

Further, the fact that the specification does not literally state the negative, namely, that a nearby device is selected from among a plurality nearby devices that are not grouped is not sufficient to establish a *prima facie* case under §112 (see MPEP 2173.05(i) and *Ex parte Parks*, 30 USPQ2d 1234, 1236 (Bd. Pat. App. & Inter. 1993) cited therein). Instead, as long as the original specification reasonably conveys to one skilled in the art that a nearby device is selected from nearby devices that are not grouped, the claims satisfy §112.

Turning to the specification, beginning on page 6, line 11, the specification explains how a user may select a device in accordance with one embodiment of the claimed invention:

"When no more response signals are received as detected at processing segment 32, the microprocessor 13 queries the GPS receiver 17 at segment 34 and determines the location of each electronic device 20 that responded relative to the location of electronic device 10 at segment 35. The microprocessor 13 then illustrates each other electronic device 20 as an icon corresponding to the device type of each other device 20 on the display 14 arranged according to their relative locations and altitudes to electronic device 10 at segment 36. If the area displayed is too large, the user can set the maximum distance that an electronic device 20 can be from the user and still be displayed. At this point, the user can select an electronic device 20 to communicate with at processing segment 37, by, for example, keyboard, mouse, touch pad input, touch screen, etc. If the user selects a device to communicate with at processing segment 37, the microprocessor 13 begins a communication routine with the selected device and returns to processing segment 37 so that the user can select another electronic device 20".

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It is clear from the above that the nearby device that is selected by a user is individually selected from nearby devices that have not been grouped either before or during the selection.

Similarly, after each device is located it is individually arranged on a display without first being grouped.

Another indication that the claimed devices are not grouped is the fact that, if an individual device is too far from a user, then it will not be displayed because the user has the option of setting the maximum distance that a device can be from the user and still be displayed. In contrast, if the device were part of a group then the specification would necessarily have to address whether the entire group cannot be displayed if an individual device within the group is too far from a user. The fact that the specification does not address such a scenario is an indication that the nearby devices are not grouped.

In the Final Office Action (see page 3) the Examiner states that "Appellant's specification seems to suggest 'grouping'" and that the "Appellant is attempting to overcome the prior art by using claim terminology from the cited references rather than Appellant's own specification" (see page 4). Appellants disagree.

None of the excerpts from the instant specification cited by the Examiner (or any other specification excerpt) discloses or suggests grouping. The excerpt from page 4 cited by the Examiner does not mention grouping, nor is grouping suggested. In fact, page 4 suggests the opposite because none of the "nearby electronic devices" are formed into groups. As consistently used throughout the present file history, "grouping" or "grouped" has meant, and means, explicitly forming a subset or subgroup of nearby electronic devices before communicating with such devices. The fact that all of the nearby devices are displayed, and not some subset of such devices, means no grouping occurs.

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Nonetheless, in the Advisory Action the Examiner "maintains that displaying devices within a certain range is a type of grouping". This is similar to the position the Examiner took in the Final Office Action when the Examiner relied upon dependent claim 3 which states that only devices "within a certain range" are displayed.

The Appellants note that because all nearby devices within a certain range are displayed, and not some subset of such devices, does not suggest grouping. Further, the Appellants note that this phrase is contained within a dependent claim, and not independent claim 19 or 32. Yet further, the Appellants note that the phrase "within a certain range" does not relate to, modify or limit the phrase ""are not grouped" within claim 19. Rather, the words in claim 3 modify the subject matter of dependent claim 30 (GPS co-ordinates). Thus, the interpretation of the subject matter of claim 3 does little to resolve the issue of the meaning of the phrase "are not grouped" within claims 19 and 32.

The Appellants also note that the phrase "are not grouped" is not found in the prior art. In fact, Fumarolo discloses just the opposite. To the extent that the *scope* of the prior art (e.g., grouping into subgroups or subsets prior to communication as in Fumarolo) is used as a consideration in amending the claims, this is unquestionably permissible. Further, the claims can be amended to use words from the entire English vocabulary provided, of course, the specification supports the use of such words (which it does).

To reiterate, the Appellants submit that the specification does not require that nearby devices be grouped. Therefore, Appellants' claims simply express what is clearly made explicit or implicit in the specification. Furthermore, even if somehow the instant specification can be interpreted as disclosing an alternative embodiment that allows for the grouping of nearby devices (i.e., does not exclude grouping), Appellants are permitted to select and claim the

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embodiments of the invention which do not require grouping (as is the case presently).

In sum, Appellants submit that one of ordinary skill in the art upon reading the claims and the specification would indeed conclude that the inventors had possession of the claimed invention, namely, methods and devices for selecting a nearby device, from among a plurality of nearby devices that are not grouped to communicate with, at the time the instant application was filed.

Accordingly, Appellants request withdrawal of the rejections and allowance of claims 19 and 32.

B. The Section 103 Rejections

(i) The combination of Fumarolo, Bork and Tognazzini does not suggest the claimed inventions

Claims 3, 5, 19 and 30-37 were rejected under 35 U.S.C. §103(a) based on the combination of Fumarolo, Bork and Tognazzini. Appellants respectfully disagree for at least the following reasons.

Initially, Appellants note that the Examiner refers to Tognazzini as U.S. Patent No. 5,906,293 (page 4) and as "Goldberg" (page 5) in the Final Office Action. Both appear to be incorrect. Appellants have requested clarification of the rejections but none has been forthcoming. For present purposes the Appellants will presume that the Examiner intends to rely on U. S. Patent No. 5,907,293 to Tognazzini.

Of the rejected claims, claims 19 and 32 are independent. It is to these claims that the Appellants now turn, it being understood that the remarks which follow apply to the remaining dependent claims.

Each of the claims of the present invention includes the features of a method or device for: (a) transmitting a Bluetooth signal; (b) detecting a

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plurality of Bluetooth signals from nearby devices that are not grouped, each signal containing GPS coordinates of at least one nearby device and a device type of the at least one nearby device; and (c) selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates.

As the Appellants understand the §103 rejections, the Examiner is relying on the combination of Fumarolo and Tognazzini for feature (b) and Fumarolo for feature (c).

Appellants note that neither Fumarolo nor Tognazzini discloses or suggests features (b) and (c) set forth above.

Turning first to Fumarolo, Fumarolo explicitly discloses the grouping of devices into "talk groups". More particularly, Fumarolo appears to select a group of devices or an individual device that have/has been grouped according to GPS co-ordinates. This is inopposite to the claimed invention.

In the Final Office Action the Examiner initially argued that Fumarolo "clearly discloses that a user selects a communication unit prior to grouping the units into a talk group", citing Figure 6 and items 605 and 613 (see page 2 of Final Office Action). In the Advisory Action the Examiner now acknowledges that Figure 6 "fails to teach the limitation". Nonetheless, the Examiner now relies upon column 3, lines 27-36 of Fumarolo. Appellants disagree.

Column 3, lines 27-36 discusses the grouping of communication units. More specifically, this excerpt from Fumarolo discusses selecting communication units with the explicit goal of grouping each selected unit into a "talkgroup". Said another way, the selection discussed in this excerpt relates to the formation of talkgroups, not the selection of a nearby device that has not been grouped associated with a detected signal, as in the claims.

Rather than disclose the selection of a communication unit prior to grouping the unit into a talk group, Fumarolo explicitly discloses selecting one

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communication unit from a talkgroup to communicate with only after the selected unit has been grouped or re-grouped into a talkgroup.

Turning to Tognazzini, the Examiner appears to rely on Tognazzini as disclosing the feature of a "detecting a device type of the nearby device" (see page 6 of the Final Office Action). Appellants disagree.

As set forth in the specification, the phrase "device type" as used in the claims means a type of *communication* device (see paragraph [0019], lines 3 and 4 of the instant specification). In contrast, the type of device disclosed by Tognazzini appears to be a vehicle (i.e., a car).

In the Advisory Action the Examiner states "even if Applicants' argument were persuasive, Tognazzi discloses that his cars can communicate using a variety of protocols including GPS, proximity radar, radio/radio-telephone. Therefore, Tognazzi's car would read on a communication device". Appellants disagree.

The Examiner's position strains credulity.

The claimed "nearby devices" are devices that transmit Bluetooth signals. Tognazzi's cars do not transmit Bluetooth signals. Nor are the claims directed at vehicles that *contain* communication devices. Instead, the claims are directed at the devices themselves. Using the Examiner's rationale, all claims directed at communication devices could be interpreted as cars provide the cars contain a communication device. Such an interpretation strains credulity.

When properly interpreted the Appellants submit that the subject matter of claims 3, 5, 19, 30-35 and 37 would not have been obvious to one of ordinary skill in the art at the time the instant application was filed based on the combined disclosures of Fumarolo, Bork and Tognazzini.

(ii) The combination of Fumarolo, Bork and Tognazzini is improper

The Appellants submit that one of ordinary skill in the art would realize that the particular Bluetooth based system in Bork could not be used in the

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system of Fumarolo or Tognazzini because such a Bluetooth system would most likely not have the distance or range needed to carry out the principle of operation of Fumarolo or Tognazzini.

Bluetooth systems provide short range communications (see Bork, column 1, lines 44-47) of approximately 100 meters (Bork, column 1, lines 51-52).

In contrast, the principle of operation in Fumarolo requires a signal to travel distances outside the range of a Bluetooth signal, as in the case where communication units belonging to a number of different agencies (i.e. fire department, police department, ambulance) must be grouped together, especially when the individuals operating such units are enroute to an incident (e.g. accident, fire).

In the Board of Patent Appeals & Interferences decision dated August 24, 2009, in supporting the Examiner's position, the Board states that both "Fumarolo and Bork disclose utilizing group communications in a limited geographic area such as several streets or a shopping mall" (Decision at page 7). However, the claims are directed at specific Bluetooth signals not the generalized "communications in a limited geographic area" referred to previously by the Board. Further, it is well known that Bluetooth signals do not propagate over several streets.

Further, the Appellants note that combining Bork and Tognazzini would also appear to require Tognazzini to impermissible change its principle of operation. In Tognazzini, a collision between two vehicles is avoided by first calculating the projected path of two vehicles and then displaying visual alerts and/or generating audible alerts (see Tognazzini, column 8, line 59 to column 9, line 4). Tognazzini appears to rely upon RF signals to calculate distances that are used to calculate the projected paths. As is known by those skilled in the art, the RF signals of Tognazzini and the claimed Bluetooth signals are not

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the same. Further, Tognazzini appears to rely upon the fact that vehicles are at some distance from one another so that its alerts can be displayed/generated and then recognized by the driver of one of the vehicles in time to avoid a collision. Given the short distance travelled by Bluetooth signals, it appears that the use of a Bluetooth signal in Tognazzini would require Tognazzini to change its principle of operation when calculating distances (i.e., distances over 100 meters could not be calculated) and eliminate the usefulness of Tognazzini's alerts (i.e., there is no time for a driver to recognize Tognazzini's alerts).

Accordingly, the Appellants maintain that the combination of Fumarolo, Bork and Tognazzini is improper for at least the reasons set forth above. The Appellants respectfully request withdrawal of the pending rejections and allowance of claims 3, 5, 19, 30-35 and 37.

Conclusion:

Appellants respectfully request that members of the Board reverse the decision of the Examiner and allow claims 3, 5, 19, 30-35 and 37 .

The Commissioner is authorized in this, concurrent, and future replies, to charge payment or credit any overpayment to Deposit Account No. 50-3777 for any additional fees required under 37 C.F.R. § 1.16 or under 37 C.F.R. § 1.17; particularly, extension of time fees.

Respectfully submitted,
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VIII. CLAIMS APPENDIX

1. (Cancelled)

2. (Cancelled)

3. The method as in claim 30 further comprising displaying only those nearby devices within a certain range.

4. (Cancelled).

5. The method as in claim 19 further comprising the step of displaying the type of nearby device associated with each detected signal.

6.-18.(Cancelled)

19. A method for selecting a nearby device, from among a plurality of nearby devices that are not grouped, to communicate with, comprising the steps of:

transmitting a Bluetooth signal;

detecting a plurality of Bluetooth signals from the nearby devices that are not grouped, each signal containing GPS coordinates of at least one nearby device and a device type of the at least one nearby device; and

selecting one of the nearby devices that are not grouped associated with one of the detected signals to communicate with based on the received GPS coordinates.

20.-29. (Cancelled)

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30. The method as in claim 19 further comprising the step of:
displaying the location of each nearby device associated with received
GPS coordinates; and
selecting the nearby device to communicate with based on the displayed
locations.

31. The method as in claim 30 further comprising selecting a nearby
device associated with a shortest location.

32. A device for selecting a nearby device, from among a plurality of
nearby devices that are not grouped, to communicate with, the device operable
to:
transmit a Bluetooth signal;
detect a plurality of Bluetooth signals from the nearby devices that are
not grouped, each signal containing GPS coordinates of at least one nearby
device and a device type of the at least one nearby device; and
selecting one of the nearby devices that are not grouped associated with
one of the detected signals to communicate with based on the received GPS
coordinates.

33. The device as in claim 32 further operable to:
display the location of each nearby device associated with received GPS
coordinates; and
select the nearby device to communicate with based on the displayed
locations.

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34. The device as in claim 33 further operable to select a nearby device associated with a shortest location.

35. The device as in claim 33 further operable to display only those nearby devices within a certain range.

36. (Cancelled).

37. The device as in claim 36 further operable to display the type of each nearby device associated with each detected signal.

IX. EVIDENCE APPENDIX

None.

X. RELATED PROCEEDINGS APPENDIX

None.